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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,797	12/14/2001	Steven M. Bessette	45112-200	1638

7590 08/21/2003

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EXAMINER
AFREMOVA, VERA

ART UNIT	PAPER NUMBER
1651	9

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/014,797	BESSETTE ET AL.	
	Examiner	Art Unit	
	Vera Afremova	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-139* is/are pending in the application.

4a) Of the above claim(s) *3,4,10,11,18,19,23-121,124,125 and 127-139* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,2,5-9,12-17,21,22,122,123 and 126* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2 and 6* .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other:

DETAILED ACTION

Election/Restrictions

Applicants' election with traverse of the Group I (claims 1 and 2) in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there is no burden to examine all claims drawn to distinct inventions in a single application. This is not found persuasive because the claimed groups of inventions are drawn to several compositions and methods having different scope and the references, which would be applied, to one group of claims would not necessarily anticipate or render obvious the other groups. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exists. Clearly different searches and issues are involved with each group. For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

In response to the applicants' request to avoid unnecessary delay and duplicative examination, the Group III (claims 5-9) and Group V (claims 12-17, 20, 21, 22, 122, 123 and 126), which are related to the scope of the elected Group I (claims 1 and 2) and drawn to compositions comprising essential oils such as rosemary oil and/or wintergreen oil with an optional diluent, have been rejoined with the elected Group I (claims 1 and 2).

Claims 3, 4, 10, 11, 18, 19, 23-121, 124, 125 and 127-139 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being

no allowable generic or linking claim. Applicants timely traversed the restriction requirement in Paper No. 8 filed 5/27/2003.

Claims 1, 2, 5-9, 12-17, 20, 21, 22, 122, 123 and 126 are under examination in the instant office action.

Claim Rejections - 35 USC § 112

Claims 1, 2, 5-9, 12-17, 20, 21, 22, 122, 123 and 126 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 5, 12, 20, 122 and 126 are indefinite because the differences in meaning between the claimed components such as "acceptable carrier" and "diluent" are uncertain in the claimed invention in the lack of definitions. The as-filed specification indicates that "diluent" might be mineral oil, d-limonene, safflower oil, citronellal or sesame oil, for example: see page 6, lines 23-28. But no definitions for the claimed term such as "acceptable carrier" are disclosed in specification. However, it is known that the essential oils, for example: rosemary oil and/or wintergreen oil, require application of carrier oils, for example: safflower oil or sesame oil or soybean oil or mineral oil, and, therefore, it appears that there is not differences between "carrier" and "diluent". Thus, the intended differences between "acceptable carrier" and "diluent" as claimed are uncertain. The meaning of the claimed terms "carrier" and "diluent" appears to be overlapping and it is further rendered confusing by the claimed phrase "optionally".

Further, claims 1, 5, 12, 20, 122, 126 are also considered uncertain and indefinite because they appear to encompass the use of rosemary oil and/or of wintergreen oil as major active

ingredients but they also encompass at least one of these oils as a diluent. Some claims encompass the same component as a major ingredient and as an optional diluent, for example: mineral oil in claim 20. Thus, the functional differences between claimed components including oils, carriers and diluents in pesticidal compositions are uncertain.

Claims 8, 9, 14, 15, 16 and 22 are indefinite with respect to the claimed amounts or the "ratio" expressed in relative "%" amounts. It is uncertain whether the claimed "ratio" is intended between rosemary oil, wintergreen oil and/or mineral oil within the whole composition comprising other optional components in addition to rosemary oil, wintergreen oil and/or mineral oil. It is uncertain whether the claimed amounts are related to the amounts of each ingredient (rosemary oil, wintergreen oil and/or mineral oil) in the whole composition. It is uncertain what composition or what subcomposition would be 100%.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Inazuka et al. (1982a) [IDS reference].

Claims are directed to a pesticidal composition comprising rosemary oil as an active ingredient and a carrier.

The reference by Inazuka et al. (1982a) discloses a pesticidal composition comprising rosemary oil as a sole active ingredient and a paper disk as a carrier (page 138, table 5). The cited reference teaches rosemary oil as an effective mosquito repellent (English abstract).

The cited reference is considered to anticipate the claimed invention because it discloses an identical composition comprising identical components including rosemary "oil" and its "carrier" wherein no "diluent" is required. The composition of the cited reference is taught to exhibit a strong mosquito repellent effect and thus, it is a pesticidal composition within the meaning of the claims. Therefore, whatever differences between pesticidal effects towards a large variety of pests including insects, which are encompassed by the intended use of the claimed composition, might be intended, the claimed composition is not structurally and, thus, functionally different from the composition of the cited patent.

Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al.

Claims are directed to a pesticidal composition comprising wintergreen oil as an active ingredient and a carrier.

The reference by Watanabe et al. discloses a pesticidal composition comprising wintergreen oil as a sole active ingredient and a paper disk or a petri dish as a carrier (see English abstract, figures 1 and 2 and table 1 at page 166). The cited reference teaches wintergreen oil as a powerful miticide (English abstract).

The cited reference is considered to anticipate the claimed invention because it discloses an identical composition comprising identical components including wintergreen "oil" and its

"carrier" wherein no "diluent" is required. The composition of the cited reference is taught to exhibit a powerful miticidal effect and thus, it is a pesticidal composition within the meaning of the claims. Therefore, whatever differences between pesticidal effects towards a large variety of pests or insects including mites, which are encompassed by the intended use of the claimed composition, might be intended, the claimed composition is not structurally and, thus, functionally different from the composition of the cited patent.

Claims 1, 2, 5, 6, 7, 12, 13, 17, 20, 21, 122, 123 and 126 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 524 383.

Claims are directed to a pesticidal composition comprising rosemary oil and wintergreen oil and a carrier/diluent. Some claims are/are further directed to a pesticidal composition comprising rosemary oil and wintergreen oil and mineral oil as a carrier/diluent. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition.

DE 524 383 teaches a pesticidal composition for combating cockroaches, bugs, etc. (see English abstract) wherein the composition comprises rosemary oil, wintergreen oil and mineral oil (petroleum). The composition of the cited patent comprises equal amounts of rosemary oil (34 g) and wintergreen oil (34 g), for example: see col. 1, lines 27 and 30.

The cited patent is considered to anticipate the claimed invention because it discloses an identical composition comprising identical components including oils and their carrier(s) or diluent(s). The composition of the cited patent is a pesticidal composition and it is taught for combating cockroaches, bugs, etc. Thus, it is used for identical purpose as the claimed composition. Therefore, whatever differences between oils/carriers and diluents might be

intended for optimization of pesticidal effects with regard to a large variety of insets as encompassed by the intended use of the claimed composition, the claimed composition is not structurally and/or functionally different from the composition of the cited patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5-9, 12-17, 20, 21, 22, 122, 123 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 524 383 taken with the references by Inazuka et al. (1982a) [IDS reference], Watanabe et al., US 4,379,168 [IDS reference], US 6,004, 569 [IDS reference] and US 5,496,857.

Claims are directed to a pesticidal composition comprising rosemary oil and wintergreen oil and a carrier/diluent. Some claims are/are further directed to a pesticidal composition comprising rosemary oil and wintergreen oil and mineral oil. Some claims are directed to the use of various carriers/diluents in the composition such as mineral oil, benzyl alcohol, citronella, d-limonene, safflower oil, soybean oil or sesame oil. Some claims are further drawn to the amounts of rosemary oil, wintergreen oil and mineral oil in the composition.

The cited patent DE 524 383 and references by Inazuka et al. and by Watanabe et al. are relied upon as explained above for the disclosure of pesticidal compositions comprising rosemary oil and/or wintergreen oil. These cited documents disclose the use of various carriers or

diluents in pesticidal compositions including mineral oil (DE 524 383) or citronellal (see Watabe et al. at table II). But they are missing the particular disclosure related to the use of carrier or diluent components such as benzyl alcohol, d-limonene, safflower oil, soybean oil and sesame oil.

However, the following documents are relied upon for the missing disclosure. For example: US 4,379,168 [IDS reference] teaches benzyl alcohol and citronellal as components of pesticidal mixtures (col. 3, lines 40-44 and line 60; col. 4, line 35). US 6,004, 569 [IDS reference] teaches the use of d-limonene as component of pesticidal mixtures. US 5,496,857 teaches safflower oil, soybean oil, sesame oil and also mineral oil as carriers and/or synergistic components in pesticidal mixtures (col. 2, lines 10-20, 43, 47, 55, 63 and 65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add acceptable carrier and/or diluent components to the compositions of the cited documents DE 524 383, Inazuka et al. (1982a) and Watanabe et al. with a reasonable expectation of success in combating pests including various insects because all components that are presently claimed have been known and used in pesticidal mixtures as acceptable carriers and/or synergistic diluents as demonstrated by the all cited references including cited documents US 4,379,168 [IDS reference], US 6,004, 569 [IDS reference] and US 5,496,857. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426

(1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary. Although the cited documents, for example: DE 524 383, do not clearly suggest all possible ratio combinations of major components as encompasses by the presently claimed invention, it is considered to be within the purview of an ordinary skill practitioner to adjust amounts of active ingredients and their carriers/diluents with regard to a particular application of a pesticidal composition.

Thus, the claimed subject matter fails to patentably distinguish over the state art as represented be the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (703) 308-9351. The examiner can normally be reached on 9.30 am - 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Vera Afremova

AU 1651

August 20, 2003.

VERA AFREMOVA

PATENT EXAMINER

V. Afremova